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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1946

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No. 792
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THE GENERAL METALS POWDER COMPANY,
Petitioner,
vs.

THE S. K. WELLMAN COMPANY and
S. K. WELLMAN,
Respondents.

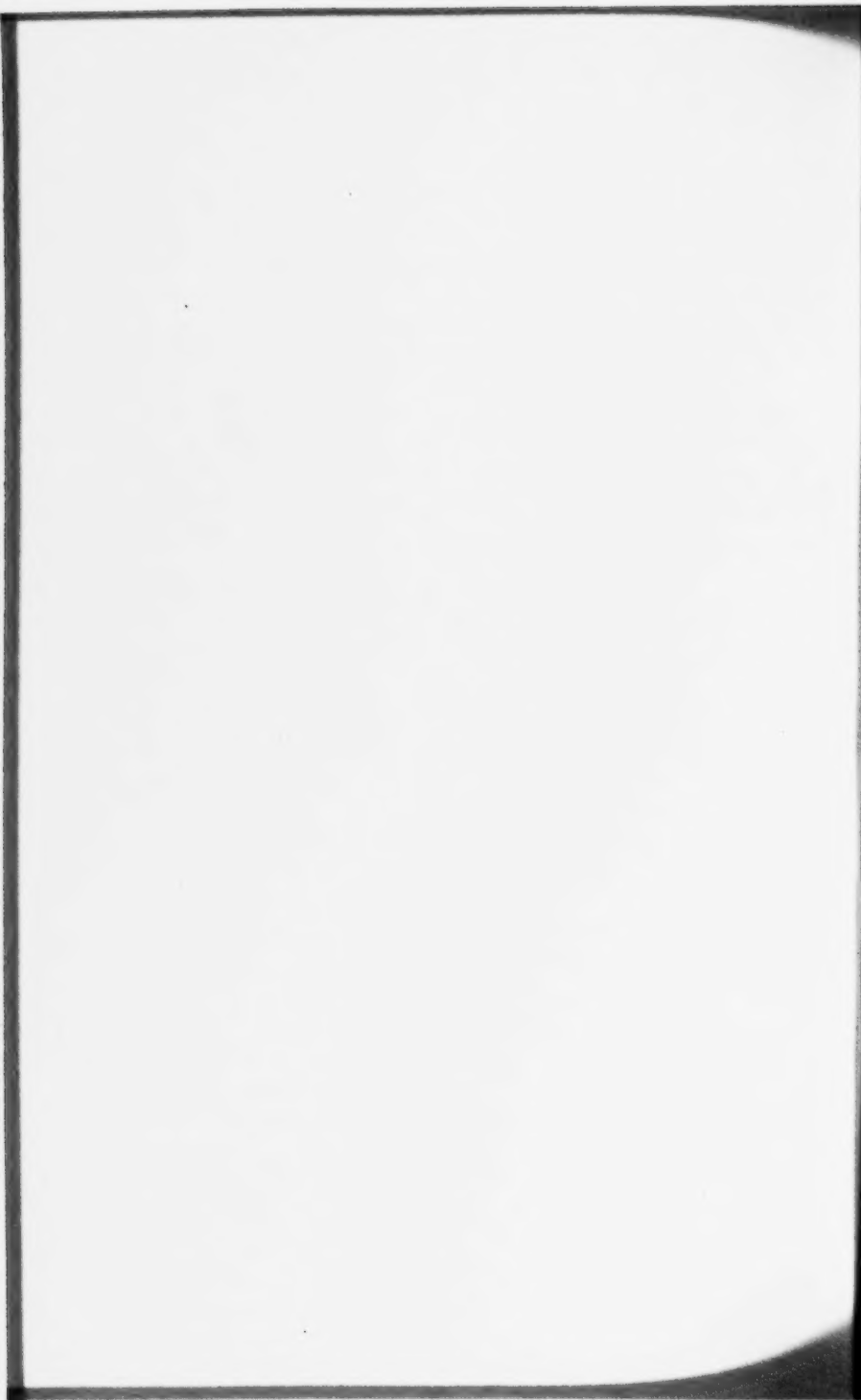
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**BRIEF OF RESPONDENTS IN OPPOSITION TO
PETITION FOR THE WRIT OF CERTIORARI.**

—
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STATEMENT OF THE CASE.

No showing is made of any special or important reason why this Court should grant the petition for the writ of certiorari. There is no conflict of decisions. On the contrary the concurring opinions of the District Court (R. Vol. II, pp. 783-788) and of the Circuit Court of Appeals affirming the District Court (R. VI, pp. 2-17; also 157 F. (2nd) 505) followed well recognized rules of law applicable to the particular facts of this cause.

This is a usual patent case grounded on two patents, to-wit: Fisher Patent No. 2,072,070, issued February 23, 1927, (R. III, p. 1) Claims 2, 3, 5, 12, 13, 14, 18 and 19 being relied upon; and Fisher Patent No. 2,191,460, issued February 27, 1940, (R. III, p. 17), Claims 1, 3, 5, and 6 being relied upon.

These two patents relate to a very old art,—that of powder metallurgy. The record discloses that the articles and the processes involved had long been known. Broadly, the articles long had been made by mixing desired metal powders and other materials and pressing them in a mold and sintering (heating) them (Findings 5 and 15, R. II, pp. 789-790).

The Fisher '070 patent relates to “. . . friction articles . . . adapted to withstand service conditions encountered in relatively moving bodies in contact with each other, such as in brakes, clutches and similar devices” (R. III, p. 7).

The patent states that “the term ‘friction article’ as used herein, means and includes, and is intended to mean and include, metallic bodies which cooperate with other parts of clutches and brakes to create the friction necessary for driving or braking purposes” (R. III, p. 13).

The Fisher '460 patent (R. III, p. 17) is concerned with the welding of a powdered metal body to a steel or other suitable backing member.

The “reasons relied upon” for allowance of the writ (Petition, pp. 2-4), “the issues” set forth in Petitioner’s brief (pp. 5, 6) and the brief throughout, are directed to the question of the meaning of the term “invention”. It is asserted that a diversity of opinion exists in our courts as to this. This Court is asked by petitioner to “furnish industry, the inventing profession, the patent law profession, the Patent Office, and the patent law courts with a definition of invention” . . . which definition it is asserted will accomplish certain allegedly desirable results (Petitioner’s Br. p. 6).

While the District Court found that the claims in suit of the two Fisher patents would have been held infringed could they be held valid (R. II, p. 791), the petition is erroneous in stating that “the judgment of the District

Court dismissed the complaint *on the ground that, as to the claims in suit, the patents were invalid for lack of invention*''* (Petition, p. 2).

It is true that the District Court held both patents in suit invalid for lack of invention (Findings 10, 11 and 16, R. II, pp. 790-791), which holding was affirmed by the Court of Appeals, but the District Court also held the claims involved of the two patents in suit invalid on other grounds as well.

The "Judgment" of the District Court was a dismissal of plaintiff's action (R. II, p. 822).

The alleged novelty of the Fisher patent No. 2,072,070 over the prior art was the residence in the "friction article", to which it related, of a "metallic network".

The District Court findings of fact in respect to this patent were: that the Patent Office was induced to grant it by erroneous assertions made by the applicant (Finding 6, R. II, p. 789); that its metal network structure was revealed in Defendant's Exhibit 48 made as early as 1922 (Finding 7, R. II, p. 789); that it was lacking in novelty over the Williams Patent of 1925, and over the Claus patent of 1927; and that the lack of novelty of the claims in suit was demonstrated by the testimony of the experts and inter-partes tests (Finding 8, R. II, p. 789). Also, that the structure embodied in the claims in suit of the said Fisher patent were, prior to Fisher, made by one Koehler; and that there was a prior sale of the friction article of the said Fisher patent and a use of it by one company in 1928, and another prior use as early as 1920 (Finding 9, R. II, pp. 789-790).

This makes it clear that the Findings of the District Court were not only Findings Numbers 10 and 11 relating to lack of invention, **but also that the Court found that the**

*Italics supplied throughout unless otherwise noted.

said Fisher patent was invalid because of erroneous representations made to the Patent Office in securing it, because of lack of novelty, and because of prior sale and use.

The District Court's Conclusion of Law Number 2 (R. II, p. 791) was that the claims in suit of the said Fisher Patent No. 2,072,070 "are invalid for lack of novelty over the prior art". "Lack of invention" is covered by Conclusion of Law Number 3 (R. II, p. 791).

The petition is likewise in error in setting forth that "lack of invention was the ground of dismissal" in respect to the other Fisher patent in suit,—No. 2,191,460 (Petition p. 2). There were additional grounds.

The District Court's Finding Number 14 is that the claims in suit of the Fisher patent '460 "are invalid for lack of novelty. They are anticipated by the Patent to Short No. 1,819,272 which was issued on August 18, 1931, on application filed September 22, 1927" (R. II, p. 790).

As to the method of welding, Finding Number 15 is that this was well known prior to Fisher's alleged invention *and that it had been used by the defendant itself*, prior to Fisher's alleged invention (R. II, p. 790).

Finding 16 is that the Fisher '460 patent is invalid *for lack of novelty* and lack of invention over the prior art (R. II, p. 791).

Conclusion of Law Number 4 is that the claims in suit of this Fisher patent are invalid for lack of novelty over the prior art (R. II, p. 791).

Conclusion of Law Number 5 is that they are also invalid for lack of invention over the prior art (R. II, p. 791).

The affirmance by the Circuit Court of Appeals was complete (R. VI, pp. 2-15, 17), (157 Fed. (2nd) 505). The Court's opinion discloses that a careful review was made.

In respect to the claims in suit of the Fisher patent 2,191,460, the Court of Appeals observes that in referring to the District Court's action "the Court held that this patent was invalid for lack of novelty and invention and that it was anticipated by Short No. 1,819,272, August 18, 1931. We think this conclusion is sustained" (R. VI, p. 16).

Thus this Fisher patent as to the claims sued upon has been held invalid for lack of novelty as well as for lack of invention by the District Court and also by the Circuit Court of Appeals.

As to the phrase "amazing results" found in the District Court's opinion, that Court's findings make it clear that whatever considerate meaning was intended, by this gratuitous observation in the opinion, the means by which the results were obtained, to-wit: the "friction article" of the first Fisher patent, was distinctly found by the Court in several items of prior art, prior patents, prior publications, prior sales and prior uses. It is in the findings, in the conclusions, and the judgment of the District Court that these authoritative pronouncements appear.

That the two agreeing courts were fully justified in holding the claims of the Fisher patents in suit invalid, we shall endeavor to briefly point out in the argument following.

ARGUMENT.

That the two concurring courts were fully warranted in holding the Fisher patent 2,072,070 invalid for lack of novelty is shown by the Williams Patent No. 1,556,658 (R. IV, p. 515). Its composition is the same as Fisher's. The process is the same old process as the District Court found. "The structural condition called a network in the Fisher patent" was old in Williams (R. II, p. 789). It should be obvious that the same material subjected to the same process

should give the same results. This was demonstrated by Dr. Wulff in inter-partes tests described by Dr. Wulff (R. I, pp. 427-437, R. IV, pp. 661-803, summarized R. I, pp. 436-437; See also Deft.'s Ex. 10, R. IV, pp. 800-803).

The lack of novelty in the '070 Fisher patent was also shown by Gilson Patent No. 1,177,407 (R. IV, p. 485). Also it is disclosed by the Claus Patent No. 1,648,772 (R. IV, p. 527).

Two chart pages from Deft.'s Physical Exhibit 44 identified by Dr. Wulff (R. II, p. 456) are inserted in this brief as Exhibit A which give a quick review of the prior art which invalidates the 2,072,070 Fisher patent.

That the said Fisher patent is invalid for lack of invention as well, is shown by the anticipating prior art such as the Williams Patent No. 1,556,658 (R. IV, p. 515); the Gilson Patent No. 1,177,407 (R. IV, p. 484); the Claus Patent No. 1,648,772 (R. IV, p. 527); the Hudson prior use (R. II, pp. 500-524, R. IV, pp. 837-952); the Guay Patent No. 1,700,493 (R. III, p. 154); the Gilson Block, Pltf.'s Ex. 48 (R. II, p. 507); the prior knowledge and use of Koehler (R. I, pp. 358 to 365); and the prior use of Cleveland Crane & Engineering Company (R. I, pp. 319-355, R. IV, p. 442). It is also shown by the Koehler Patent No. 1,479,859 (R. IV, p. 491); Williams Patent No. 1,766,865 (R. III, p. 253); Sherwood Patent No. 1,873,223 (R. IV, p. 573); Gilson Patent No. 1,093,614 (R. IV, p. 481).

As to the Fisher patent No. 2,191,460, the Short patent No. 1,819,272, which was issued August 18, 1931 on application filed September 22, 1927 (R. IV, p. 569) is an anticipation as found by the District Court and affirmed by the Circuit Court of Appeals. This patent discloses a porous metallic facing welded to a denser metallic backing. That it anticipates is clear from a mere comparison of the Short

patent's disclosure with that of the 2,191,460 Fisher patent in suit. That the said Fisher patent is also void for lack of invention is shown by abundant evidence on the record which wholly supports the finding of the District Court on the "invention" issue.

Fisher contributed nothing to the art. The "friction article" of his first patent 2,072,070 was old. The welding of this to a backing plate to which the Fisher patent 2,191,460 relates was old,—and old with the defendant before Fisher made his alleged invention as the District Court found (Finding 15, R. II, p. 790).

We shall not attempt to analyze or reply to the many decided cases cited and quoted in petitioner's brief. Petitioner's discussion of theories and of tests respecting "invention" overlooks a few tests of patentability. Novelty is one; prior use, prior sale, prior knowledge and prior publication are the others. These are set forth in the Patent Act (R. S. Sec. 4886; U. S. Code, Title 35, Sec. 31).

On the record in the instant cause the petitioner's philosophizing on the subject of "invention" seems academic. However, it may be observed that petitioner hopes for too much in asking this Court to define "invention". It is thought that it would be as difficult to give this legal term a definition of specificity as it would be to define "reasonable conduct", "mechanical skill", "reasonable time", "necessity" or other equally naked words or phrases. All of these, like the word "invention", must be fully dressed with facts in a particular case before there is any stuff out of which definition can be fashioned. Also, it may be observed that the urgent "prayer" found on page 6 of the petition for a "definition of invention" is not accompanied by any specific suggestion as to how anyone can evolve the definition requested.

In respect to illustrative decided cases, the Circuit Court of Appeals mentioned some in its opinion, and related them to the facts at bar. For instance, the opinion states:

“There must be ‘some substantial innovation . . . , an innovation for which society is *truly indebted* to the efforts of the patentee.’ (Italics ours.) *Sinclair & Carroll Co., Inc. v. Inter-Chemical Corp.*, 325 U. S. 327, 330. It is elementary that invention must involve something more than the work of a skilled mechanic charged with the state of the prior art.”

We do not understand from petitioner’s brief that such principles as these are attacked. They have been followed for long years.

It would be difficult to choose language more aptly applicable to the lack of novelty found as a fact by both the trial and reviewing courts, than that quoted from the opinion of the Circuit Court of Appeals.

The petitioner’s argument (page 14 of Brief) that this Court’s *Sinclair* decision has brought confusion into the law respecting “invention” is unwarranted. Each of the cases to which Petitioner refers of necessity was treated upon its own particular facts. The question of invention must always be resolved by the exercise of judgment upon facts adduced. Facts differ, and courts sometimes differ in their views respecting them. It follows that every court opinion must be read with the admonition of Chief Justice Marshall in mind:

“It is a maxim not to be disregarded, that general expressions, in every opinion, are to be taken in connection with the case in which those expressions are used. If they go beyond the case, they may be respected, but ought not to control the judgment in a subsequent suit when the very point is presented for decision. The reason of this maxim is obvious. The question actually before the court is investigated with

care, and considered in its full extent. Other principles which may serve to illustrate it, are considered in their relation to the case decided, but their possible bearing on all other cases is seldom completely investigated." *Cohens v. Virginia*, 6 Wheaton 264, at 399; 19 L. Ed. 262, at 398.

Since the District Court with complete justification found the first Fisher patent in suit invalid for lack of novelty, because of prior use, prior sale, prior knowledge, prior publication, and lack of invention, and upon equally good warrant, found the second Fisher patent invalid for lack of novelty and lack of invention, and since each of these determinations was affirmed by the Circuit Court of Appeals, the petition for the writ of certiorari should be denied.

Respectfully submitted,

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